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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,192	11/14/2001	Sangki Rhee	4220-116.1 US	8974

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,192

Applicant(s)

RHEE ET AL.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/674,617.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Receipt is acknowledged of a reply to the previous Office Action, filed November 7, 2003. Amendments were made to the claims.

It is noted that Applicant has used the improper indicators for claims 18-20. These claims should properly be indicated as "Withdrawn" since the claims were withdrawn from consideration in the previous Office Action. However, in the interest of compact prosecution, a letter of Non-responsiveness is not being sent out regarding this matter.

Claims 17-20 are pending and in the instant application. Claims 18-20 have been withdrawn as being drawn to a non-elected invention. Claim 17 is under consideration in the instant application. Any rejection of record in the previous Office Action, mailed August 12, 2003, that is not addressed in this action has been withdrawn.

This application contains claims 18-20 drawn to an invention nonelected with traverse in the Paper filed May 20, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Because this Office Action only maintains rejections set forth in the previous Office Action and/or sets forth new rejections that are necessitated by amendment, this Office Action is made FINAL.

Priority

Applicant has not satisfied the requirements of correcting the priority claim for the instant invention. Specifically, Applicant has not provided a grantable petition

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accompanied by the appropriate surcharge and a statement regarding the unintentional nature of the delay. This is covered in detail on page 5 of the previous Office Action. Because applicant has not satisfied the requirements to perfect the priority claim, the priority claim of the instant application remains the date of filing of the instant application, November 14, 2001.

Specification

The disclosure is objected to because of the following informalities: Applicant has improperly amended the specification to include a priority claim in the first line of the specification. This amendment is NOT entered because: it is not accompanied by a grantable petition, surcharge and letter stating the unintentional nature of the delay, each of which is required to permit the amendment of the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This rejection is maintained for the reasons set forth in the previous Office Action.**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **This rejection is maintained for the reasons set forth in the previous Office Action.**

Response to Arguments Concerning the Claim Rejections - 35 USC § 112

Applicant's arguments filed November 7, 2003 have been fully considered but they are not persuasive. Applicant's arguments appear to be predicated simply on the entry of the amendment. However, the amendment does not address several issues set forth in the previous Office Action, therefore Applicant's arguments by definition do not address these issues.

Applicant's amendment does not substantially change the nature of the claimed invention in that it still requires a description of the *KEX1* coding sequence. It is clearly set forth in the previous Office Action (for example see page 8) that the instant specification fails to describe the coding sequence of *KEX1*. The specification simply sets forth a ~3500 nucleotide long sequence that is purported to encode a carboxypeptidase α protein, without indicating the open reading frame of the gene that encodes the protein (i.e., where is the Start/ATG codon;), or by describing the corresponding amino acid sequence that is encoded by the nucleic acid. Within the context of an ~ 3500 nucleotide sequence (which can conceivably encode many different

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proteins since the entire sequence encodes for almost 1200 amino acids in three alternative reading frames), it is impossible to determine what the coding sequence of the *KEX1* gene is. Because of this fact, the skilled artisan cannot know which proteins in which open reading frames represent the *KEX1* gene product, and therefore cannot reasonably determine which coding sequences are and are not encompassed by the claimed invention. As such, Applicant has both failed to describe the coding sequence of *KEX1* (112, first paragraph), and failed to specifically define the metes and bounds of the claimed invention (112, second paragraph).

Because the skilled artisan cannot be apprised of what sequence actually encodes for the *KEX1* gene product, and which coding sequences are included or excluded by the claim, the instant claims do not satisfy the requirements of 35 USC § 112, first and second paragraphs. For these reasons, the rejection set forth in the previous Office Action is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Rhee *et al.*

This rejection is maintained for the reasons set forth in the previous Office Action.

Response to Arguments Concerning the Claim Rejections - 35 USC § 102

Applicant's arguments filed November 7, 2003 have been fully considered but they are not persuasive. Applicant's traversal is predicated on the perfection of the priority claim. However, as indicated above, Applicant has not satisfied the necessary requirements to perfect the priority claim; therefore, the priority claim is still considered invalid. As a result, Applicant's arguments and request for removal of the rejection are moot.

Allowable Subject Matter

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571)272-0771 . The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571)272-0781. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson, Ph.D.
AU 1636



JAMES KETTER
PRIMARY EXAMINER